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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT PAPER NUMBER

2161

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

09/819,649

Applicant(s)

NAKAZATO, TOSHIAKI

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A. SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/10/2004 has been entered.

Claims Status

Claims 1-21 are pending. Claims 1-21 are rejected.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15–21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites “if necessary, restoring the backed up analysis related information in said second storage device into said first storage device.” The scope of the invention cannot be determined because it is unclear whether the data from the second storage device is transferred to the first storage device.

Claims 16-21 are rejected for being dependent from a rejected base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7, 8 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,675,166 issued to Bova (hereafter Bova).

Claims 1 and 8:

Regarding claims Bova discloses :

- an analyzing unit [specific tissue reagent is related to previous and subsequent research, col 4, lines 40-55] for analyzing requested item of a measured sample
- an analysis related information database [computer-implemented database (DA), Fig 1, 16, col 4, lines 15-24] for holding analysis related information necessary for analyzing said sample
- a database manager [Fig 5, project manager template, col 8, lines 15-20] for storing [patients template, lines 35-65] inputted said analysis related information into said analysis related information database and outputting [user access to data, Fig 5, col 8, lines 15-30] information from said analysis related information database
- a data access controller [Fig 5, project manager template, col 8, lines 15-20] for controlling storing said analysis related information into said analysis related information

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database and outputting therefrom in a text-based file format [col 6, lines 35-47] provided with a header [Fig 13, col 10, lines 53-57, col 12, lines 8-13] defining a data item identifier for each data item and functioning as a key field for data retrieval of each data item [col 4, lines 55-65]

- a data import controller [col 4, lines 25-40] for importing into the database reagent data and reference sample data of the sample to be analyzed, which is collected by a remote computer, in the same text-based file format as the stored analysis related information,
- wherein said analysis related information is stored in the text-based file format as a data storage format by each data item in the database, thereby enabling inputting and retrieving directly from said database without data format conversion [col 6, lines 35-46]

Claims 2 and 11:

Bova discloses an on-line communication unit [Fig 1] for exporting said analysis related information into a database in other computer connected outside to said system and importing said analysis related information from said other computer into said analysis related information database.

Claims 3 and 12:

Bova discloses wherein said on-line communication unit imports and exports said analysis related information in a file format provided with a header defining a data item identifier for each data item [col 11, line 66- col 12, line 7]

Claims 4 and 13:

Bova discloses wherein said file format is XML format [col 6, lines 35-47].

Claim 7:

Bova discloses a display unit for displaying said analysis related information [col 20, lines 10-27].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bova in view of US Pat. No. 6,345,278 issued Hitchcock et al (hereafter Hitchcock).

Claims 5 and 14:

Bova discloses the elements of claim 1 as noted above. Bova fails to disclose CSV format. Hitchcock discloses CSV format [col 21, lines 1-5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bova to include CSV format as taught Hitchcock for the purpose of tailoring the individual elements to the specifications of a particular institution [col 20, lines 65-67]. The skilled artisan would have been motivated improve the invention of Bova by including CSV such that data can be more easily stored and retrieved by using a common data format.

1. Claims 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bova in view of US Pat No 5,434,971 issued to Lysakowski (hereafter Lysakowski).

Claims 6, 9:

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Bova discloses the elements of claims 1, 8 as noted above. Bova fails to disclose an editor for editing data. Lysakowski discloses an editor for editing data [col 4, line 66 through col 5, line 2]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bova to include an editor as taught by Lysakowski for the purpose of editing the configuration structure [col 4, line 67].

Claim 10:

The combination of Bova and Lysakowski discloses the elements of claims 8 and 9 as noted above. Bova discloses an I/O controller for controlling display of inputting and outputting screen accessing said analysis related information database according to the editing in said editor [inherent in Fig 2].

2. Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bova in view of the combination of US Pat No 5,930,791 issued to Leu (hereafter Leu), US Pat No 6,353,878 issued to Dunham (hereafter Dunham), and US Pat No 5,742, 807 issued to Masinter (hereafter Masinter), as best examiner is able to ascertain.

Claim 15:

Bova discloses:

- an analyzing unit [specific tissue reagent is related to previous and subsequent research, col 4, lines 40-55] for analyzing requested item of a measured sample
- a first storage device [computer-implemented database (DA), Fig 1, 16, col 4, lines 15-24] for holding analysis related information necessary for analyzing said sample

- a database manager [Fig 5, project manager template, col 8, lines 15-20] for storing inputted said analysis related information into said first storage device and outputting information from said first storage device

Bova discloses the elements as noted above but fails to disclose a backup recovery processor for backing up all or part of said analysis related information stored in said first storage device into a second storage device other than said first storage device. Leu discloses a backup recovery processor for backing up all or part of said analysis related information stored in said first storage device into a second storage device other than said first storage device [Fig 1, 20, col 4, lines 15-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bova to include a backup recovery processor for backing up all or part of said analysis related information stored in said first storage device into a second storage device other than said first storage device as taught by Leu for the purpose of retrieving data [col 4, line 23]. The skilled artisan would have been motivated to improve the invention of Bova by including a backup database such that data can be securely stored in a second/different database. Data can then be retrieved from the second/different database if for some reason the data in the first database is lost or corrupted.

The combination of Bova and Leu discloses the elements as noted above. The combination of Bova and Leu fails to disclose wherein each backed up piece of information is provided with tag information identifying at least one analyzing device, time stamp, and correction information. Dunham discloses wherein each backed up piece of information is provided with tag information identifying at least one analyzing device, time stamp, and correction information [Fig 8, 133, col 16, lines 5-25]. It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modify the combination of Bova and Leu to include wherein each backed up piece of information is provided with tag information identifying at least one analyzing device, time stamp, and correction information as taught by Dunham for the purpose of identifying the backup version [col 16, lines 5-25]. The skilled artisan would have been motivated to improve the invention of the combination of Bova and Leu per the above for the purpose of tracking the history of the data in the backup database.

The combination of Bova, Leu and Dunham discloses the elements of claim 15 as noted above. The combination of Bova, Leu and Dunham fails to disclose wherein said backup recovery processor backs up said analysis related information in a plurality of steps by data items of said related information in accordance with a volume of data targeted for backup. Masinter discloses and wherein said backup recovery processor backs up said analysis related information in a plurality of steps by data items of said related information in accordance with a volume of data targeted for backup [Fig 6, col 6, lines 5-19]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Bova, Leu, Dunham to include and wherein said backup recovery processor backs up said analysis related information in a plurality of steps by data items of said related information in accordance with a volume of data targeted for backup as taught by Masinter for the purpose of improving reliability and security of repository access and operation [col 2, lines 31-40].

Claim 16:

The combination of Bova, Leu, Dunham and Masinter discloses the elements of claim 15 as noted above. Furthermore, Bova discloses a data access controller [Fig 5, project manager template, col 8, lines 15-20] for controlling storing said analysis related information into said analysis related information database and outputting therefrom in a text-based file format [col 6, lines 35-47] provided with a header [Fig 13, col 10, lines 53-57, col 12, lines 8-13] defining a data item identifier for each data item.

Claim 17:

The combination of Bova, Leu, Dunham and Masinter discloses the elements of claim 15 as noted above. Furthermore, Bova discloses a controller for converting said analysis related information into a file format [col 6, lines 35-47] provided with a header [Fig 13, col 10, lines 53-57, col 12, lines 8-13] defining a data item identifier for each data item when storing said analysis related information into said first storage device. Leu discloses outputting backing up thereof in said second storage device [Fig 1, 20]

Claim 18:

The combination of Bova, Leu and Dunham and Masinter discloses the elements of claim 15 as noted above. Furthermore, Leu discloses a display unit [Fig 1, 22] for displaying a selecting screen for selecting target information to be backed up into said second storage device from information in said first storage device or target information to be restored into said first storage device from information in said second storage device

Claim 19:

The combination of Bova, Leu and Dunham and Masinter discloses the elements of claim 15 as noted above. Furthermore, Leu discloses an online communication unit for connecting said first storage device and said second storage device with online network [Fig 1]

Claims 20 and 21:

Bova discloses wherein said file format is XML format [col 6, lines 35-47].

Response to Arguments

Applicant's arguments filed 9/10/2004 have been fully considered and found partially persuasive. However, in order to advance prosecution regarding what constitutes a "text-based file format" above new art rejection is provided.

First Applicant Argument:

Applicant states on page 9, "First, Applicants note independent claims 1 and 8 recite that the analysis related information is stored in a 'text-based file format.' The outstanding Office Action indicates Leu discloses such a feature at column 4, lines 57-65. However, in that respect Applicants note Leu does not disclose that the stored information in the predetermined data format in the 'symmetrical-type' database is in a 'text' based file format such as CSV or XML."

First Examiner Response:

Examiner is not persuaded for the reasons given below. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., CSV or XML) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

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USPQ2d 1057 (Fed. Cir. 1993). Nevertheless, in order to advance prosecution by reducing needless arguments regarding the claimed “text-based file format,” examiner provides above new art rejection over Bova who clearly discloses text in an XML format. As Bova discloses XML as a typical language for use in a browser-based implementation of the database (DA), examiner maintains that Bova reads on “text-based file format.”

Second Applicant Argument:

Applicant states in the first paragraph on page 10 “Moreover, Leu does not achieve or suggest achieving benefits that can be realized with the claimed benefits:

Second Examiner Response:

Examiner is not persuaded for the reasons given below. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., achieving benefits) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Third Applicant Argument:

Applicant states in the third paragraph on page 11 “With respect to independent claim 15, applicants respectfully submit that Leu does not disclose or suggest the feature clarified in claim 15 that ‘said backup recovery processor backs up said analysis related information in a plurality of steps by data items of said analysis related information in accordance with the volume of data targeted for backup.’ Leu simply does not teach or suggest any type of phased backup operation as now clarified in independent claim 15.”

Third Examiner Response:

Examiner is not persuaded. Examiner maintains that every backup process is inherently "phased" due to physical limitations of the transmission medium. The limited bandwidth of the transmission medium necessitates a phased backup procedure. However, in order to advance prosecution by limiting needless arguments, examiner introduces above new art rejection of instant limitation in view of Masinter who clearly teaches phased implementation of the backup recovery process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Etienne LeRoux

11/12/2004.


SAFET METJAHIC
SUPERVISOR
TECHNOLOGY CENTER